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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/020,605	12/11/2001	Bharadwaj S. Amrutur	10010107-1	6541

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AGILENT TECHNOLOGIES, INC.
Legal Department, DL429
Intellectual Property Administration
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EXAMINER

TORRES, JOSEPH D

ART UNIT	PAPER NUMBER
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2133

DATE MAILED: 06/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/020,605

Applicant(s)

AMRUTUR ET AL.

Examiner

Joseph D. Torres

Art Unit

2133

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 September 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. Previous 35 USC § 112 rejections of the claims are withdrawn.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-10 and 34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The term "original data bit stream" in claims 1, 6 and 34 is a relative term which renders the claim indefinite. The term "original data bit stream" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. The term "original data bit stream" is a relative term because the term, "original data bit stream", depends from where the data originates and unless the source that originates the "original data bit stream" is specified, it is not clear from where the "original data bit stream" originates from, that is, it is not clear what the "original data bit stream" is nor is it clear why the data bit stream warrants being called an "original data bit stream" nor is it clear how such claim language further limits a data bit stream.

Claim Rejections - 35 USC § 101

3. Previous 35 USC § 101 rejections of the claims are withdrawn.

Response to Arguments

4. Applicant's arguments filed 04/22/2005 have been fully considered but they are not persuasive.

The Applicant contends, "Adam does not teach or anticipate scrambling an original data bit stream and converting said original data bit stream into scrambled data".

The Examiner disagrees and asserts that K1', K2', K3', D1, D2 and D3 (304 in Figure 3 of Adam) originate from Reading Block 202 and Control Character Encoding and Byte Reordering Block 204 in Figure 2 of Adam; hence K1', K2', K3', D1, D2 and D3 is an original data bit stream originating from Reading Block 202 and Control Character Encoding and Byte Reordering Block 204.

The Applicant contends, "in Figure 1 of Adam, an original data stream 102 is encoded by an encoder 104 prior to being inserted into an FEC encoder 106".

Nowhere in the Adam patent does Adam refer to the data stream 102 as an original data stream and while the Examiner concedes that data stream 102 can be considered an original data stream with respect to its originating source; K1', K2', K3', D1, D2 and D3 (304 in Figure 3 of Adam) is also original data with respect to the originating source for K1', K2', K3', D1, D2 and D3, that is, K1', K2', K3', D1, D2 and D3 is also original

data with respect to originating source Reading Block 202 and Control Character Encoding and Byte Reordering Block 204 in Figure 2 of Adam.

The Applicant contends, "Claim 34, this claim has been amended to recite, among other things, a "scrambler device programmed to convert a received bit stream, having data bits therein, into scrambled data, said received bit stream being without redundant bits and without being encoded prior to being scrambled.""

The Examiner asserts that K1', K2', K3', D1, D2 and D3 (304 in Figure 3 of Adam) is without redundant bits and is not encoded prior to scrambling.

The Examiner asserts that, it appears the Applicant is attempting to claim the Applicant's invention using functional language or intended use language. The Examiner would like to point out that the intended use language or functional language in the Applicant's claim language does not result in any tangible structural change, that is, the Applicant has substantially extracted Scrambling Block 206 and the FEC Encoding Block of 210 from Figure 2 of Adam and is now calling that the Applicant's invention. An Inventor could just as easily extract the engine from a Ford Motor car to make it available for other uses and call the extracted engine his invention or how about extracting a processor from a Dell computer to make it available for other uses? The Examiner asserts that the Applicant's claim language does not result in any structural difference from Reading Block 202 and Control Character Encoding and Byte Reordering Block 204 in Figure 2 of Adam, See, e.g., In re Schreiber, 128 F.3d 1473,

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1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997) and In re Swinehart, 439 F.2d 210, 212-13, 169 USPQ 226, 228-29 (CCPA 1971).

The Examiner disagrees with the applicant and maintains all rejections of claims 1-10 and 34. All amendments and arguments by the applicant have been considered. It is the Examiner's conclusion that claims 1-10 and 34 are not patentably distinct or non-obvious over the prior art of record in view of the reference, Adam; Joel Fredric et al. (US 6628725 B1, hereafter referred to as Adam) as applied in the last office action, filed 02/07/2005. Therefore, the rejection is maintained.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 5-8 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Adam; Joel Fredric et al. (US 6628725 B1, hereafter referred to as Adam).

See the Non-Final Action filed 02/07/2005 for detailed action of prior rejections.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
 2. Ascertaining the differences between the prior art and the claims at issue.
 3. Resolving the level of ordinary skill in the pertinent art.
 4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 3, 4, 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adam; Joel Fredric et al. (US 6628725 B1, hereafter referred to as Adam) in view of Kimmitt; Myles (US 6738935 B1).

See the Non-Final Action filed 02/07/2005 for detailed action of prior rejections.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

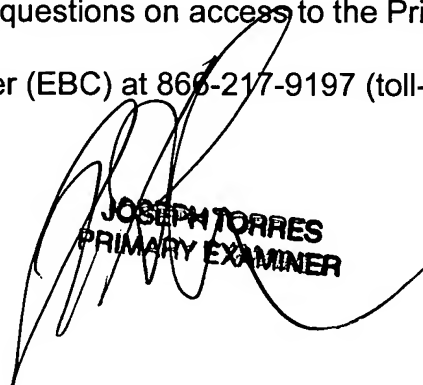
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph D. Torres whose telephone number is (571) 272-3829. The examiner can normally be reached on M-F 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on (571) 272-3819. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



JOSEPH D. TORRES
PRIMARY EXAMINER

Joseph D. Torres, PhD
Primary Examiner
Art Unit 2133